

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF : Virgil Allen WATSON, et al.
SERIAL NO. : 10/589,012
FILED : April 26, 2007
TITLE : SIGNAGE CONSTRUCTION METHOD AND
APPARATUS
Group/A.U. : 1791
Conf. No. : 4193
Examiner : Robert C. Dye
Docket No. : P06721US1

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This is an appeal from the Final Rejection of claims 2, 4, 6 - 13 and 15 - 19 dated October 14, 2009.

I. Real Party In Interest:


The real party in interest of the instant appeal is Lomont Molding, Inc., d/b/a Paragon Products, 1516 E. Mapleleaf Drive, Mt. Pleasant, IA 52641-3117 US.

II. Related Appeals and Interferences:

There are no related appeals or interferences.

Certificate of Electronic Transmission

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via EFS-Web (United States Patent and Trademark Office's web-based patent application and document submission) on this 2nd day of December, 2009.


Timothy J. Zarley, Reg. No. 45,253

III. Status of the Claims:

Presently, claims 2, 4, 6 - 13 and 15 - 19 are pending in the application and appear as Appendix A of this brief. Claims 1, 3, 5, and 14 have been cancelled. Claims 2, 4, 6 - 13 and 15 - 19 are identified as the appealed claims.

IV. Status of Amendments:

Since the Final Rejection of October 14, 2009, no further amendments have been filed.

V. Summary of Claimed Subject Matter:

Claim 2 is directed to a sign (20) for viewing by persons in a traffic area accessible by the random passage of persons through the area, comprising a label (22) formed of a flexible thermoplastic substrate upon which the subject matter of the desired sign (20) is printed. (Page 6, lines 28 - 31). There is a planar substrate (24) of injected thermoplastic molded material fused to the label (22). (Page 6, lines 31 - 32; Page 5, lines 6 - 10). The planar substrate (24) includes a mounting feature (26) adapted to secure the sign (24) to a second object. (Page 7, lines 2 - 4). Additionally, the second object is a second sign (20') and the mounting feature (26) secures the first sign (20) to a back side (28) of the second sign (20') located opposite from the label (22). (Page 7, lines 21 - 28).

Claim 9 is directed to a method of manufacturing a sign (20), comprising the step of providing a first (A) and second (B) sign mold portion located opposite from one another. (Page 8, lines 16 - 18). The method also includes the step of associating an injection device (46) with the first sign mold portion (A). (Page 8, lines 25 - 26). Further included is the step of associating an ejector system (50) with the

first sign mold portion (A). (Page 9, lines 3 - 4). The method also comprises the steps of placing a label (22) in the second sign mold portion (B), closing the first (A) and second (B) sign mold portions together, and injecting the first sign mold portion (A) via the injection device (46). (Page 11, lines 26 - 32). Finally, the method includes the step of removing a previously formed sign (20) from the first sign mold portion (A) via the ejector system (50) prior to closing the mold portions (A, B) together wherein the ejector system (50) contacts the formed sign (20) on a side opposite from the label (22). (Page 9, lines 11 - 13; lines 4 - 6).

VI. Grounds of Rejection to be Reviewed on Appeal:

Claims 2 and 4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams et al. (USP 5,800,757), (hereinafter "Abrams"). Claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams as applied to claim 2, and further in view of Eberle et al (USP 6,131,320) (hereinafter "Eberle") or Weiner et al. (USP 4,541,190) (hereinafter "Weiner"). Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams as applied to claim 2 and further in view of Bowers et al. (PG Pub 2003/0154639) (hereinafter "Bowers"). Claim 8 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams in view of Bowers as applied to claim 7 and further in view of Wardle (USP 4,131,657) (hereinafter "Wardle"). Claims 9, 10, 11, 12, 15 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts (WO03/016017) (hereinafter "Alberts") in view of Abrams. Claim 13 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams as applied to claim 12 and further in view of Assalita et al. (USP

5,922,367) (hereinafter "Assalita"). Claim 16 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams as applied to claim 15 and further in view of Hasl et al (USP 4,880,368) (hereinafter "Hasl"). Claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams and Hasl as applied to claim 16 and further in view of Hellmer et al. (USP 4,397,625) (hereinafter "Hellmer").

VII. Argument:

The Rejection of Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Abrams

Claim 2:

Independent claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams. In addition, in the Response to Arguments section of the 10/14/2009 Office Action, the Examiner mentions Eberle et al. (USP 6,131,320) and Bowers et al. (PG Pub 2003/0154639) as further evidence of obviousness. Appellant cannot agree because each and every limitation of amended claim 2 is not taught by a combination of the prior art references either individually or in combination. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 2 requires, in-part, *"wherein the second object is a second sign and wherein the mounting feature secures the first sign to a back side of the second sign located opposite from the label."* Abrams does not teach this limitation and instead teaches a mold 20 that is used to mold a back board 200 including placing a sheet or film 204 thereon. (Col. 19, lines 51-56). The backside of the backboard is best shown by Fig. 20 as rib members 202 and a second sign is not utilized. Thus, this limitation is not met and the rejection is considered overcome.

According to the 10/14/2009 Office Action:

Abrams teaches mounting features but does not disclose that the mounting feature is adapted to attach to a second sign. Abrams teaches that the sign is capable of various uses including a point-of-sale sign (Fig. 21). Since it is well-known in the marketing industry to use two-sided point of use promotion signs to attract customers from two directions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the promotional sign of Abrams to another molded identical promotional sign in order to attract customers from two directions.

(Page 3, paragraph 7).

There is no reason or support in the prior art to modify Abrams in this way. Instead, such a modification is accomplished only through the use of improper hindsight reasoning where Applicant's claim is used as a blueprint using that which was taught by the Applicant against the Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 277 USPQ 543,547 (Fed. Cir. 1985).

Abrams teaches a mold for a basketball backboard wherein the backside of a backboard is typically up against a garage or not seen by a user. There is no teaching within

Abrams regarding two sided point of use promotion signs which attract customers as asserted by the office action. For that matter Applicant has not claimed a two sided sign and instead claims a second sign wherein the mounting feature of the first sign secures the first sign to a backside of the second sign located opposite from the label. The office action has not pointed to any teaching in any prior art reference either in Abrams or otherwise that would teach or suggest modifying Abrams to utilize a second sign on the back of the backboard that potentially will not be seen by the viewing public. Instead, the only motivation or reason to modify Abrams as discussed in the office action comes from Applicant's own disclosure. Applicant asserts this is improper hindsight reasoning and evidence of non obviousness. Id. Thus, Applicant respectfully requests the rejection be withdrawn.

Furthermore, Eberle does not cure the deficiencies of Abrams. In contrast, Eberle teaches "a free-standing, foldable floor sign includ[ing] an integrally formed handle portion and male and female hinge projections." (Abstract). More specifically, Eberle teaches two panels which are connected at the handle portion located at the top of the device. (See Fig. 1). Accordingly, Eberle does not teach *"wherein the second object is a second sign and wherein the mounting feature secures the first sign to a back side of the second sign located opposite from the label."*

Bowers also does not cure Abrams and Eberle. Bowers teaches a display frame which receives a layer of elements located between the sign body and a front cover lens. ([0014]; see also Fig. 2). Bowers further teaches two sign bodies connected together. However, Bowers teaches these two sign bodies "in a side-by-side relation and mounted on a support surface." ([0033], see also Fig. 7). Accordingly,

Bowers does not teach *"wherein the second object is a second sign and wherein the mounting feature secures the first sign to a back side of the second sign located opposite from the label."*

For the above reasons, the prior art to Abrams, Eberle and Bowers, individually, or in combination, fails to teach each and every limitation of Applicant's claim 2, and Appellant requests that the rejection be withdrawn.

The Rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams

Claim 9:

Independent claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams. Appellant cannot agree because neither Alberts nor Abrams, alone or in combination, discloses each and every element of claim 9. Claim 9 requires, in-part, *"wherein the ejector system contacts the formed sign on a side opposite from the label."* Abrams provides no disclosure of an ejector system (See generally, Abrams), and the Office Action relies on Alberts to meet this limitation. However Alberts cannot cure Abrams because Alberts fails to disclose an ejector system that contacts a formed sign on a side opposite from the label. Instead, Alberts discloses a transfer device 4 which removes an earlier formed product 48 from the mold cavity 14 with vacuum cups 56 which engage the same side of the finished (label included) product 48 onto which the label 60 has been molded (Alberts, page 7, line 6 - page 8, line 16, See especially Fig. 5), and thus does not contact a formed sign on a side opposite from the label, as required by claim 9.

Therefore, because neither Alberts nor Abrams, alone or in combination, disclose an ejector system that contacts a formed sign on a side opposite from the label, the references cannot combine to meet each and every limitation of claim 9. Accordingly, the Appellant respectfully requests that the rejection be withdrawn.

The Rejection of Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Abrams and in further view of Eberle

Claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams in further view of Eberle. Claim 6 depends upon on claim 2, and for at least this reason reversal is requested, as Applicant hereby reasserts the above arguments advanced in favor of claim 2.

The Rejection of Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Abrams and in further view of Bowers

Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams in further view of Bowers. Claim 7 depends upon on claim 2, and for at least this reason reversal is requested, as Applicant hereby reasserts the above arguments advanced in favor of claim 2.

The Rejection of Claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Abrams in view of Bowers and in further view of Wardle

Claim 8 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams in view of Bowers and in further view of Wardle. Claim 8 indirectly depends upon claim 2, and for at least this reason reversal is requested, as

Applicant hereby reasserts the above arguments advanced in favor of claim 2.

The Rejection of Claims 10, 11, 12, 15 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams

Claims 10, 11, 12, 15 & 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams. Claims 10, 11, 12, 15 & 19 depend upon claim 9, either directly or indirectly, and for at least this reason reversal is requested, as Applicant hereby reasserts the above arguments advanced in favor of claim 9.

The Rejection of Claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams and in further view of Assalita

Claim 13 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams and in further view of Assalita. Claim 13 indirectly depends upon claim 9, and for at least this reason reversal is requested, as Applicant hereby reasserts the above arguments advanced in favor of claim 9.

The Rejection of Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams and in further view of Hasl

Claim 16 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams and in further view of Hasl. Claim 16 indirectly depends upon claim 9, and for at least this reason reversal is requested, as Applicant hereby reasserts the above arguments advanced in favor of claim 9.

The Rejection of Claim 17 under 35 U.S.C. § 103(a) as
being unpatentable over Alberts in view of Abrams and
Hasl in further view of Hellmer

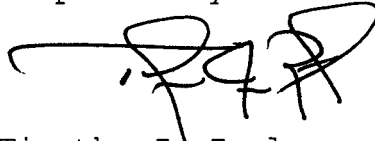
Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams and Hasl in further view of Hellmer. Claim 17 indirectly depends upon claim 9, and for at least this reason reversal is requested, as Applicant hereby reasserts the above arguments advanced in favor of claim 9.

Conclusion

In conclusion, Appellant respectfully requests reversal of the final rejection. Appellant believes claims 2, 4, 6 - 13 and 15 - 19 are in proper form for allowance, and Appellant respectfully requests allowance of these claims.

A payment in the amount of \$270.00 is being submitted with this appeal brief. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Zarley', with a stylized flourish at the end.

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Attachment: Appendix

APPENDIX A

VIII. Claims Appendix

2. A sign for viewing by persons in a traffic area accessible by the random passage of persons through the area, comprising:

a label formed of a flexible thermoplastic substrate upon which the subject matter of the desired sign is printed;
a planar substrate of injected thermoplastic molded material fused to the label; and

wherein the planar substrate includes a mounting feature adapted to secure the sign to a second object;

wherein the second object is a second sign and wherein the mounting feature secures the first sign to a back side of the second sign located opposite from the label.

4. The sign of claim 2, wherein the planar substrate further includes a stiffening rib located on a back side of the sign located opposite from the label, the stiffening rib strengthening the planar substrate to resist deformation.

6. The sign of claim 2, wherein the mounting feature is a male snap element adapted to mate with a corresponding female snap element on the second sign.

7. The sign of claim 2, wherein each sign has a front side including the label, a back side located opposite from the front side, and an end extending between the front side and back side, the mounting feature is located on the end of the first sign, and wherein the mounting feature secures the

first sign to the end of the second sign so that the labels of the first and second signs are contiguous.

8. The sign of claim 7, wherein the mounting feature is a groove adapted to mate with a corresponding groove on the second sign.

9. A method of manufacturing a sign, comprising:
providing a first and second sign mold portion located
opposite from one another;
associating an injection device with the first sign mold
portion;
associating an ejector system with the first sign mold
portion;
placing a label in the second sign mold portion;
closing the first and second sign mold portions together; and
injecting the first sign mold portion via the injection
device; and
removing a previously formed sign from the first sign mold
portion via the ejector system prior to closing the mold
portions together
wherein the ejector system contacts the formed sign on a side
opposite from the label.

10. The method of claim 9, wherein the steps of placing the label and removing the previously formed sign are performed simultaneously.

11. The method of claim 9, wherein the steps of placing the label and removing the previously formed sign are performed by an automated device, and wherein the automated device need

only enter between the first and second sign mold portions a single time to perform both steps.

12. The method of claim 9, wherein the injection device injects directly into the first sign mold portion.

13. The method of claim 12, wherein the injection device injects directly into the first sign mold portion through a heated sprue bushing, and further comprising the step of operating the heated sprue bushing to eliminate the need to manually trim the sign.

15. The method of claim 9, wherein the steps of placing the label and removing the previously formed sign are performed by an automated device, and wherein the automated device includes a guidance portion adapted to mate with a corresponding guidance member located on the second sign mold portion to properly align the label with the second sign mold portion.

16. The method of claim 15, further comprising the automated device acquiring a label from a label hopper, wherein the guidance portion of the automated device is adapted to mate with a corresponding guidance member located on the label hopper to properly align the label with the automated device.

17. The method of claim 16, further comprising adjusting the orientation of the label with respect to the second sign mold portion via an orientation adjustment mechanism located on the label hopper.

18. The method of claim 17, wherein the orientation adjustment mechanism is adapted to adjust the orientation of the label with respect to the second sign mold portion in a lateral direction, vertical direction, and rotational direction.

19. The method of claim 9, further comprising providing a first set of labels having a first graphic, providing a second set of labels having a second graphic, and placing at least one label from the first set of labels and at least one label from the second set of labels in the second sign mold portion.

IX. Evidence Appendix

None

X. Related Proceedings Appendix
None